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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL E. LaSALLE

Appeal 2009-005627
Application 10/779,960
Technology Center 3700

Decided: October 14, 2009

Before: JENNIFER D. BAHR, STEVEN D.A. MCCARTHY, and
MICHAEL W. O'NEILL, *Administrative Patent Judges.*

BAHR, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Michael E. LaSalle (Appellant) appeals under 35 U.S.C. § 134 (2002) from the Examiner's decision rejecting claims 12-14 and 25-27. Claims 1-11, 15-24, and 28-37 have been cancelled. We have jurisdiction over this appeal under 35 U.S.C. § 6 (2002).

The Invention

Appellant's claimed invention is directed to fabricating, handling, and transporting elongate bags of material, such as loose-fill thermal insulation. Layers of the bags are stacked on pallets in a cross-stacked pattern, where at least one bag is orthogonal to the lengthwise bags. Fig. 1B. This configuration makes it easier for a forklift to lift the products, but more difficult for a clamping stacker machine to grab, move, and stack the layer of bags in the first place because the clamping forces can cause the lengthwise bags to slip past one another, leading to roll-out, where the bags fall from the clamp. Spec. 2:12 to 3:2, fig. 1C. Therefore, the clamp of the stacker machine of the claimed invention, made of stacking head 303 and fingers 305A-D, further includes chains 307A and 307B that become sandwiched between the lengthwise bags, providing enough friction between the clamped bags to prevent roll-out. Spec. 8:10 to 9:10, fig. 3.

Claim 12, reproduced below, is illustrative of the claimed invention.

12. A method of handling material comprising:

 packaging material into elongate bags;

 automatically arranging the elongate bags
 into groups, wherein at least one group has a cross-
 stacked configuration wherein a first set of bags
 are disposed side-by-side along their lengths and at

least one additional bag is disposed orthogonal to and adjacent said first set of bags; and

automatically lifting and transporting said groups of elongate bags, group by group, to form a multi-row stack of elongate bags, said lifting and transporting accomplished by applying opposed clamping forces to opposite sides of at least one group having a cross-stacked configuration while preventing elongate bags disposed side-by-side in said cross-stacked configuration from sliding past one another, said opposed clamping forces being applied to only two sides of the at least one group and said opposed clamping forces alone being sufficient to lift the at least one group;

wherein said automatic lifting and transporting said groups of elongate bags is carried out by a stacker machine having a moveable stacker head with two fingers that apply opposed clamping forces to grip a given group of elongate bags and at least one support structure that is operably disposed between bags disposed side-by-side in said cross-stacked configuration to prevent such bags from sliding past one another while not providing resistance to the opposed clamping forces.

The Rejections

The Examiner relies upon the following as evidence of unpatentability:

| | | |
|----------|--------------|---------------|
| Pagdin | US 2,920,916 | Jan. 12, 1960 |
| Milholen | US 3,992,049 | Nov. 16, 1976 |
| Tygard | US 5,516,255 | May 14, 1996 |
| Seaberg | US 6,135,704 | Oct. 24, 2000 |

Appellant seeks review of the Examiner's rejections under 35 U.S.C. § 103(a) of claims 12 and 25 as being unpatentable over Pagdin and Tygard and, alternatively, over Pagdin, Seaberg, and Tygard; and of claims 13, 14, and 25-27 as unpatentable over Pagdin, Tygard, Applicant Admitted Prior Art¹, and Milholen.

SUMMARY OF DECISION

We REVERSE and enter a NEW GROUND of REJECTION.

ISSUE

In relevant part, claims 12 and 25 both require a lifting machine with fingers that apply a clamping force to cross-stacked bags, the machine having a support structure operably disposed between the lengthwise bags, the support structure "not providing resistance to the opposed clamping forces." However, as the Examiner notes, Appellant's claimed support structure inherently provides resistance to the opposed clamping forces of fingers 305. Ans. 6. Therefore, the dispositive issue in this appeal is whether a person of ordinary skill in the art would be able to ascertain the metes and bounds of the limitation recited in claims 12 and 25, in which a support structure is described as operably disposed between bags "while not providing resistance to the opposed clamping forces," when that limitation is read in light of Appellant's Specification.

¹ The Examiner's rejection does not specify what admissions of Appellant are relied upon in rejecting these claims.

PRINCIPLES OF LAW

"The claim language itself defines the scope of the claim." *Eastman Kodak Co. v. Goodyear Tire & Rubber Co.*, 114 F.3d 1547, 1552 (Fed. Cir. 1997) (quoting *York Prods., Inc. v. Central Tractor Farm & Family Center*, 99 F.3d 1568, 1572 (Fed. Cir. 1996)). However, "[c]laims must be read in view of the specification, of which they are a part." *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995) (citing *Autogiro Co. of Am. v. United States*, 384 F.2d 391, 397 (Ct. Cl. 1967)). *See also In re ICON Health & Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007) ("[T]he PTO must give claims their broadest reasonable construction consistent with the specification").

The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986) (citations omitted). The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. *In re Johnson*, 558 F.2d 1008, 1015 (CCPA 1977). In determining whether this standard is met, the definiteness of the language employed in the claim must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. *Id.*

ANALYSIS

Claims 12 and 25, in relevant part, recite a support structure operably disposed between the lengthwise bags, the support structure "not providing resistance to the opposed clamping forces." The plain meaning of the claimed support structure "not providing resistance" is that the support structure provides zero resistance to the clamping force. *See Eastman Kodak Co.*, 114 F.3d at 1552 ("The claim language itself defines the scope of the claim.").

The Specification, however, implies a different meaning. *Cf. Markman*, 52 F.3d at 979 (claims must be read in view of the Specification) and *Orthokinetics*, 806 F.2d at 1576 (the test for definiteness is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification"). In the Specification, the support structure, made of chains, ropes, wires, or the like, fits between the two lengthwise bags in the cross-stacked pattern and prevents these bags from slipping past one another by providing friction between the bags. Spec. 8:19 to 9:5. The friction force provided by the support structure is a result of the forces pressing the lengthwise bags together against the support structure. Thus, some amount of the clamping force applied to the ends of the lengthwise bags is transferred to the support structure. As pointed out by the Examiner, this force transferred through the bags to the support structure must inherently result in the support structure providing some amount of resistance to the force. Ans. 6. If the support structure did not provide some amount of resistance, it would be crushed or moved, and ineffective in providing friction between the bags for the bag handling machine. Thus, we find that Appellant's Specification inherently discloses that the support

structure provides some amount of resistance to the clamping forces, but is silent regarding the degree of this resistance. This disclosure stands in stark contrast to a support structure "not providing resistance," as required by claims 12 and 25.

Therefore, reading claims 12 and 25 in light of Appellant's disclosure, as we must, we find an inexplicable inconsistency within claims 12 and 25, which renders claims 12 and 25 indefinite. *See In re Cohn*, 438 F.2d 989, 993 (CCPA 1971) (sustaining rejection of claims under 35 U.S.C. § 112, second paragraph, as being indefinite when the claims were inherently inconsistent with the description, definitions, and examples appearing in applicant's specification). Further, the prior art rejections must fall because they are necessarily based on a speculative assumption as to the meaning of the claims. *See In re Steele*, 305 F.2d 859, 862-63 (CCPA 1962). It should be understood, however, that our decision in this regard is based solely on the indefiniteness of the claimed subject matter, and does not reflect on the adequacy of the prior art evidence applied in support of the rejection.

CONCLUSION

Claims 12 and 25 are indefinite because of the inexplicable inconsistency between the claimed disposition of a support structure between the bags "while not providing resistance to the opposed clamping forces" and the description of the support structure in the Specification. Likewise, dependent claims 13, 14, 26, and 27 are indefinite. Consequently, we will not sustain the Examiner's prior art rejections, because they are necessarily based on speculative assumption as to the meaning of the claims.

DECISION

The Examiner's decision is reversed as to claims 12-14 and 25-27. Pursuant to our authority under 37 C.F.R. § 41.50(b) (2008), we enter a new ground of rejection of claims 12-14 and 25-27 as indefinite under 35 U.S.C. § 112, second paragraph.

FINALITY OF DECISION

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner....

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record....

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). See 37 C.F.R. § 1.136(a)(1)(iv) (2007).

REVERSED; 37 C.F.R. § 41.50(b)

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